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EXAMINER	
WARD, JESSICA LEE	

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Washington, DC 20006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/607,986

Applicant(s)

CRUZ, EUGENIO

Examiner

Jessica L. Rossi

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 December 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

As set forth in paragraph 4 of the previous action, the present specification does not have proper antecedent basis for the limitations in original claim 12. Applicant should amend the specification to include these limitations.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 5-11 stand rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US 2002/0100231, of record).

With respect to claim 1, Miller teaches a method of fabricating a product comprising locating a resin soaked sheet 14 having a decorative motif on a board 16 (Figure 3, sections [0020-0023]), placing the resin soaked sheet and board into a press machine (not shown) having a press plate with a 3D surface (not shown) while the press plate is in a raised position (section [0035]), curing the resin at a predetermined temperature while pressing the resin soaked sheet and board with the press plate at a predetermined pressure such that a laminated product is

Art Unit: 1733

produced (section [0035]), wherein placing of the resin soaked sheet and board into the press machine aligns the decorative motif of the resin soaked sheet with the 3D surface of the press plate and wherein the produced laminated product has a surface texture that is embossed in registration with the decorative motif (Figure 1B, sections [0009, 0029, 0032]).

Regarding claims 5-7, Miller teaches such (section [0035]; teaches $350-400^{\circ}\text{F} = 176-204^{\circ}\text{C}$, $380-420\text{ psi} = 27-30\text{ kg/cm}^2$, and 18-60 seconds).

Regarding claims 8-9, Miller teaches protective resin-impregnated wear layer 12 located on top of the resin soaked sheet 14 (Figure 3; sections [0024-0026]).

Regarding claims 10-11, Miller teaches a resin-impregnated base layer 24 located under the board 16 (Figure 3; sections [0020-0021]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. as applied to claim 1 above and further in view of Hunter et al. (US 5413834, of record).

Regarding claim 4, Miller is unclear as to milling a hollow in the surface of the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to mill a hollow in the bottom surface of the board of Miller because it is known in the art to mill a hollow in the surface of a board opposite that having a resin soaked decorative paper layer thereon where this imparts flexibility in the form of bending capabilities to the laminate, as

Art Unit: 1733

taught by Hunter (column 1, lines 64-68; column 2, lines 4-12; column 5, lines 45-53; column 6, lines 8-13).

6. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. as applied to claim 10 above and further in view of Cannady et al. (US 3648358, of record).

Regarding claim 12, Miller teaches the resin soaked decorative sheet being a paper layer impregnated with a thermosetting resin (section [0023]) but is unclear as to a type of paper and thermosetting resin. Selection of a particular paper and thermosetting resin would have been within purview of one having ordinary skill in the art depending on the desired characteristics thereof. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kraft paper impregnated with thermosetting melamine resin because it is known in the art to impregnate Kraft paper with such a thermosetting resin and use it for a decorative sheet in a decorative laminate, as taught by Cannady (column 3, lines 27-36).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 1733

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-12 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,638,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '387 patent encompass the limitations set forth in the claims of the present application.

Allowable Subject Matter

9. The following is a statement of reasons for the indication of allowable subject matter:

Upon filing a proper terminal disclaimer to overcome the obviousness-type double patenting rejection set forth in paragraph 10 above, claim 2 will be allowable because the prior art fails to teach or suggest milling reference edges on the board and locating the resin soaked sheet on the board relative to the milled reference edges of the board such that the decorative motif assumes a predetermined position on the board relative to the reference edges and a predetermined position relative to the three dimensional surface of the press plate. It is noted that claim 3 depends from claim 2.

Response to Arguments

10. At the bottom of p. 5 of the remarks, Applicant argues that Miller does not disclose or suggest "placing the resin soaked sheet and board into the press machine aligns the decorative motif of the resin soaked sheet with the three dimensional surface of the press plate."

The examiner disagrees. The laminate of Miller comprises board 16, resin soaked sheet 14 having a decorative motif, and wear layer 12 (see Figure 3). Miller teaches embossing a

Art Unit: 1733

textured surface into the wear layer by placing the laminate into a press machine equipped with a press plate having a 3D surface (section [0035]). Miller also teaches that the textured surface embossed into the wear layer is *in registration* with the decorative motif of the resin soaked sheet (section [0032]). Therefore, one would readily appreciate that this registration would not be possible unless the laminate is placed/positioned within the press machine such that the decorative motif is aligned with the 3D surface of the press plate.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

Art Unit: 1733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JESSICA ROSSI
PRIMARY EXAMINER

